



**BRIEF IN SUPPORT OF PETITION FOR  
WRIT OF CERTIORARI**

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**Statement of the Case with Reference  
to Claims 1 to 3**

Your petitioners filed applications for patent in the United States Patent Office, Serial No. 752,462 on November 10, 1934, Serial No. 757,891 on December 17, 1934, and Serial No. 234,952 on October 14, 1938, relating to improved detergent compositions containing either soap or a synthetic detergent and a polyphosphate of either the triphosphate or the tetraphosphate form.

During the prosecution of the first two said applications, the Patent Office determined that part of the subject matter relating to detergent tetraphosphate compositions was patentable and issued a patent, No. 2,092,913, thereon to a junior applicant, Augustus H. Fiske (application filed October 5, 1935, R. 81-84).

When your petitioners called the attention of the Examiner to the fact that their applications disclosed the same patentable subject matter, the Examiner declared an interference between claim 29 of your petitioners' application, Serial No. 752,462, and claim 4 of the said Fiske patent, and this claim 29, relating to synthetic detergent tetraphosphate compositions, was allowed to your petitioners in view of the judgment that your petitioner Lind was the prior inventor of this subject matter (R. 180, also R. 151).

The Examiner held, however, that because of certain Patent Office rules of interference procedure, your petitioners were *estopped* from receiving claims 1 to 3 of the patentable subject matter common to your petitioners' application Serial No. 234,952 and the said Fiske patent

(R. 145-150) relating to soap and tetraphosphate compositions. An appeal from this ruling was taken to the Board of Appeals, and the refusal of these claims to your petitioners on the sole ground of estoppel was affirmed by the Board of Appeals on June 18, 1940 (R. 150-153).

In the action before the District Court, the sole question brought before the Court by your petitioners' appeal as to these claims was the propriety of their refusal to your petitioners by the Board of Appeals *on the ground of estoppel*. The question of patentability, having already been determined, was not before the District Court.

The bill of complaint states:

"5. That on June 18, 1940, the Board of Appeals unjustly affirmed the final refusal of the said claims as set forth in Schedule A \* \* \*"

(i.e. claims 1 to 3) (R. 3). The sole ground of action before the District Court on these claims was thus the correctness of the decision of the Board of Appeals of June 18, 1940 (R. 150-153) refusing these claims only on the ground of estoppel.

The District Court held that your petitioners (plaintiffs) were estopped to assert claim 1, but *were not estopped to assert claims 2 and 3* (Conclusions of Law Nos. 1 and 2, R. 10), but instead of directing the issuance of a patent on claims 2 and 3, it held that these claims (previously allowed by the Patent Office) were unpatentable over the prior art (Finding No. 19, R. 10). The District Court went into a question not brought before it for decision and reversed a prior Patent Office determination that these claims were patentable.

On appeal the Court of Appeals affirmed the entire decision below in a per curiam memorandum without opinion (R. 191). It did not pass upon whether the estoppel also was inapplicable to claim 1 (a point spe-

cifically before it), or whether the District Court had jurisdiction to reopen and pass upon the question of patentability which had previously been decided in petitioners' favor by the Patent Office.

The fact that the patentability of claims 1 to 3 was not before the District Court and that it had no authority to reverse the prior administrative determination that these claims were patentable, was called to the attention of the Court of Appeals in a petition for rehearing, but this petition was denied (R. 193).

### **Statement of the Case with Reference to the Remaining Claims**

Claims 1 to 3, which the Patent Office determined to be patentable, relate to detergent compositions containing a detergent and an alkali metal salt of tetraphosphoric acid (for example, sodium tetraphosphate). The remaining claims of the applications relate generically to detergent compositions containing a detergent and an alkali metal salt of a polyphosphoric acid. The polyphosphoric acids are tetraphosphoric acid and triphosphoric acid (R. 27).

Sodium tetraphosphate and sodium triphosphate are substantial equivalents in detergent compositions (R. 33). They were both discovered to be "particularly valuable" in detergent compositions by your petitioner Lind (see application, R. 44) and they are both classed in the same chemical class as "polyphosphates" (R. 35).

The remaining claims are therefore closely related to claims 1 to 3 which the Patent Office has previously determined are patentable. Claims 1 to 3 are specific claims to detergent tetraphosphate compositions, whereas the remaining claims define the composition more generically as including polyphosphates, i.e., triphosphates and tetraphosphates.

In the Patent Office these remaining claims to detergent compositions containing a detergent and a polyphosphate were held to be unpatentable over prior art patents which disclosed the use of other phosphates, such as orthophosphates, pyrophosphates and metaphosphates, but which did not disclose polyphosphates generically or triphosphates or tetraphosphates specifically (R. 153-162).

Affidavits (R. 67 to 80) were filed in the Patent Office showing that the polyphosphates were definitely superior in detergent compositions to the prior used phosphates, but the Examiner held these affidavits to be "not convincing" and "not supported by technical data" (R. 163-164), and the rejection was affirmed by the Board of Appeals (R. 164-168), which said:

"\* \* \* it appears to us that appellant has done nothing more than carry forward the teachings of the prior art" (R. 167).

In the District Court, your petitioners produced testimony and exhibits (R. 13-35, and Exhibits 10 and 11) which showed that the polyphosphates and particularly the triphosphates in detergent compositions are not merely the equivalent of but are superior in many respects to all other known phosphates used in detergent compositions; that they solve a problem of long standing in the detergency field, namely, the prevention of flocs and scums and the ring around the bathtub when soap is used in hard water; that the polyphosphates had been available to the soap and detergent industry for over forty-five years, and yet it had not occurred to any of the skilled chemists in this industry to use them in detergent compositions; that from prior chemical knowledge, and reasoning therefrom, it could not be assumed that the intermediate polyphosphates would be superior to the higher (metaphosphates) and lower (orthophosphates) members of the phosphate series, and that contrary to what one

would expect the polyphosphates produced a better answer to the problems encountered in the use of detergents in hard water than did any of the phosphates previously suggested or used.

The District Court without commenting on the evidence, handed down a memorandum reading:

“Judgment for Defendant on estoppel and on merits”  
(R. 7)

but in making later findings of fact found that there was no disclosure of the use of detergents and alkali metal triphosphate or tetraphosphate in the prior art, but that no invention was involved in view of the prior use of other phosphates in detergent compositions (Finding No. 17, R. 10).

The Court of Appeals affirmed this decision in a per curiam memorandum (R. 191) on authority of its own previous decisions of *Abbott v. Coe*,<sup>1</sup> *Potts v. Coe*,<sup>2</sup> and *Radtke Patents Corporation v. Coe*.<sup>3</sup> A petition for rehearing was denied (R. 193).

### Specification of Errors

(1) The United States District Court and the Court of Appeals for the District of Columbia erred in reversing the judgment of the Patent Office that claims 1, 2 and 3 involved invention and were patentable. Having found that the only ground on which these claims were rejected to your petitioners, namely, estoppel, was unsound in law, the Courts should have reversed the rejection on estoppel and

<sup>1</sup> 71 App. D. C. 195, 109 F. (2d) 449.

<sup>2</sup> U. S. App. , 140 F. (2d) 470, 472-473, see also decision on motion to vacate, 62 USPQ 331.

<sup>3</sup> 74 App. D. C. 251, 268, 122 F. (2d) 937, 964.

there ended their decisions. They should not have assumed unto themselves the Patent Office function of determining invention and patentability in the first instance, where a decision on this issue was not necessary to dispose of the appeals before them.

(2) The District Court and the Court of Appeals erred in substituting their judgment for the judgment of the Patent Office on the question of patentability of claims 1 to 3 in the absence of a finding that there was not sufficient evidence to support the Patent Office decision that these claims *involved invention and are patentable*.

(3) The District Court and the Court of Appeals erred in rejecting the remaining claims of petitioners' applications by measuring the question of invention with a different standard than that set forth in R.S. Sec. 4886 and by using an arbitrary standard which is not based on the evidence of invention submitted and the rules for the interpretation of such evidence, but on the personal viewpoint of the judges of the Court.

## Argument

### Claims 1 to 3

The Patent Office having determined that claims 1 to 3 involved invention and were patentable, and having previously issued a patent thereon to Fiske (R. 81-84) and having refused the claims to your petitioners only on the ground of estoppel, the only issue before the District Court and the Court of Appeals as to these claims was whether the estoppel set up against your petitioners in the Patent Office was proper as a matter of law. When the District Court determined as a matter of law that your petitioners were not estopped to assert claims 2 and 3 (R. 10) it disposed of the only question

raised by your petitioners' action as to these claims and should have directed the grant of a patent to Lind on these claims, as Lind had previously demonstrated his priority over Fiske (R. 150), who had received a patent (R. 81) (See R. S. 4904, *supra*).

The Court's decision could not recall the patent previously issued to Fiske by the Patent Office, nor could its decision reflect on the validity of the Fiske patent which was not before it. The Court should not have substituted its judgment for the judgment of the Patent Office on a matter of patentability *vested primarily in the Patent Office*, and on which it was *not required to rule by the issues raised in your petitioners' suit*.

R. S. Sec. 482 (U. S. C., Title 35, Sec. 7) vests final jurisdiction in the Board of Appeals in the Patent Office to review and determine the validity of adverse decisions of the Examiner. When the Board of Appeals reviewed the Examiner's decision that claims 1 to 3 were patentable to Lind over the prior art but rejected to Lind on the ground of estoppel and affirmed the refusal of claims 1 to 3 to Lind solely on estoppel (R. 150-153), the District Court and the Court of Appeals had no authority to go over the head of the administrative tribunal vested with primary jurisdiction and into a question not raised by petitioners' suit and determine invention and patentability in a way contrary to the determination of the administrative tribunal. *National Labor Relations Board v. Waterman Steamship Corporation*, 309 U. S. 206. *Federal Communications Commission v. Pottsville Broadcasting Company*, 309 U. S. 134. *Securities and Exchange Commission v. Chenery Corporation*, 318 U. S. 80. *Rochester Telephone Corporation v. United States*, 307 U. S. 125. *Interstate Commerce Commission v. Jersey City*, 88 L. Ed. 1064, at 1068-1069. *Abbott v. Coe*, 109 F. (2d) 449. For pertinent quotations from these decisions see appendix.



## Argument

### Remaining Claims

The District Court, after hearing evidence for two days and receiving exhibits which were not before the Patent Office, on the state of the art, on the progress over the art and on the question of invention, without discussing this new evidence and without a written opinion, entered a memorandum—

“Judgment for Defendant on estoppel and on merits” (R. 7).

The Court of Appeals affirmed the District Court in a per curiam memorandum referring only to three previous decisions by it, namely, *Abbott v. Coe*,<sup>1</sup> *Potts v. Coe*,<sup>2</sup> and *Radtke Patents Corporation v. Coe*.<sup>3</sup>

The testimony and exhibits show that detergent compositions containing a detergent and an alkali metal salt of a polyphosphoric acid are superior to any other detergent-phosphate composition for use particularly in hard water, and that they also show an improvement when used in soft water (R. 24).

The new detergent compositions fill a long felt want in the industry, namely, the improvement of washing conditions in hard water, the elimination of scum, etc.

Soap compositions containing the triphosphate or the tetraphosphate, when used in hard water, do not produce a scum or a ring around the bathtub, but produce a dense, strong lather and good detergent action defi-

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<sup>1</sup> 71 App. D. C. 195, 109 F. (2d) 449.

<sup>2</sup> U. S. App. , 140 F. (2d) 470, 472-473, see also decision on motion to vacate, 62 USPQ 331.

<sup>3</sup> 74 App. D. C. 251, 268, 122 F. (2d) 937, 964.

nitely superior to the use of soaps or soap and other phosphates in hard water washing operations (R. 22, 23). Synthetic detergents with polyphosphates show superiority in many respects over all other phosphates with synthetic detergents (R. 14-22 and 28-32).

The problems caused by the use of hard water in household washing and industrial operations had been before the industry for many years. All of the phosphates, including the polyphosphates had been known for "forty-five to fifty years" (R. 34) and the tetraphosphate approximately one hundred years (R. 81). Prior chemical knowledge indicated that the tetraphosphates and the triphosphates, which are higher dehydrated forms of orthophosphates, would break down in water solution and revert to the orthophosphate which was known to be less satisfactory (R. 28). The applicant Lind discovered that the triphosphates and the tetraphosphates, contrary to expectations based on chemical reasoning, would stand up for normal washing and detergency operations, and that they were in many ways superior in detergent compositions to all of the other known phosphates (R. 26).

The District Court and the Court of Appeals, without showing any analysis of this overwhelming evidence of the superiority of applicant's claimed products over the prior art, of their solution of a long standing problem, and the failure of other skilled workers in the industry to discover applicant's solution, although all the ingredients were available for the solution for over forty-five years, refused, on the authority of three previous decisions of the Court of Appeals of the District of Columbia, to direct the grant of a patent on the remaining claims.

R. S. Sec. 4886 provides that—

"Any person who has invented or discovered a new and useful \* \* \* composition of matter or any new and useful improvement thereof \* \* \* may \* \* \* obtain a patent therefor."

The criteria of the statute is that the composition of matter shall be new and useful. By the findings of the District Court the compositions are new.

“No disclosure of the use of a synthetic detergent and an alkali metal triphosphate or tetraphosphate is found in the prior art” (Finding No. 17, R. 10).

That the composition defined in your petitioners' claims is not only useful but is superior in a great many respects to previous detergent compositions is amply shown by the evidence. See, for example, Exhibits 10 and 11. That the compositions defined were not obvious to others skilled in the art and solved a long standing need is also demonstrated by the fact that the problem of a satisfactory hard water detergent had been before the industry for years, and that the polyphosphates on which the present compositions are based had been known for more than forty-five years and none of the skilled chemists in the detergent industry had produced the new and useful composition claimed by your petitioners.

Both the District Court and the Court of Appeals therefore applied a standard of invention that is not required by the statute and is contrary to the standard applied by other courts in dealing with problems of this type.

In *In re Shortell*, 61 USPQ 362, the Court of Customs and Patent Appeals has held:

“\* \* \* when patentable subject matter is properly applied for and claimed, it is patentable if the thing claimed was not anticipated, was *not obvious* to one skilled in the art, and the other conditions named in section 4886 of the Revised Statutes (U. S. C., title 35, sec. 31) are met.

\* \* \* \* \*

“Until very recently the decisions of all courts having jurisdiction over patent matters have uniformly held that if the thing patented involved patentable subject

matter, was useful and was not anticipated by the prior art *nor obvious to one skilled in the art*, it evidenced invention and was patentable, other conditions prescribed by the statute necessary to patentability being present.

"Congress has frequently amended section 4886, *supra*, but has never seen fit to require *higher standards* for the determination of invention than those so frequently declared by the courts. It, therefore seems to us that the rule of legislative adoption of judicial decision is applicable, and that the standards declared by the courts *previous to such amendments have become the settled law not subject to judicial repeal*. See *Electric Storage Battery Co. v. Shimadzu et al.*, 307 U. S. 5 (41 USPQ 155).

"Much controversy has arisen concerning the interpretation of certain language in the case of *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 (51 USPQ 272), wherein, following the citation of a number of cases, the court said (51 USPQ 272, 275):

\* \* \* That is to say, the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain.

"It is interesting to note that all of the cases cited by the court preceding the above quotation were decided upon the familiar basis of whether the thing patented involved more than the skill of the art involved. In view of this fact, we are of the opinion that the use of the term 'flash of creative genius', above quoted, was intended to mean nothing more than that the thing patented must involve more than the skill of the art to which it relates.

\* \* \* \* \*

"In our opinion *it is not within the province of the courts to establish new standards* by which invention is to be determined. It seems clear to us that the

creation of *new standards* for the determination of what constitutes invention would be *judicial legislation and not judicial interpretation*.

"It follows, from the foregoing, that until Congress shall otherwise legislate, or the Supreme Court shall otherwise specifically hold, this court will continue to hold that if a process or thing constitutes patentable subject matter, is new and useful, and the process performed or thing produced *would not be obvious to one skilled in the art*, invention should be presumed and a patent may properly issue therefor" (pp. 366-367, italics supplied).

In *Goodyear Tire & Rubber Company, Inc. et al. v. Ray-O-Vac Company*, 60 USPQ 386, 88 L. Ed. 475, this Court has said:

"Viewed after the event, the means Anthony adopted seem simple and such as *should have been obvious* to those who worked in the field, but this is not enough to negative invention. During a period of *half a century*, in which the use of flash light batteries increased enormously, and the manufacturers of flash light cells were conscious of the defects in them, no one devised a method of curing such defects" (p. 388).

The solution of a long-felt need by a new means or composition has been recognized as indicating invention and above the normal skill of the art in *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486; *The Barbed Wire Patent*, 143 U. S. 275; *Carnegie Steel Company v. Cambria Iron Company*, 185 U. S. 403-429, and *Smith v. Snow*, 294 U. S. 1.

In *Universal Oil Products Company v. Globe Oil & Refining Co.* (decided May 29, 1944), 88 L. Ed. 1055, at 1063-1064, this Court said:

"Retrospective simplicity is often a misleading test of invention where it appears that the patentee's

*conception in fact solved a recognized problem that had baffled the contemporary art; \* \* \*.*" (Italics supplied.)

The District Court and the Court of Appeals of the District of Columbia have, however, followed neither the statute nor these decisions, nor the evidence, but have apparently followed an arbitrary standard of invention which disregards the fact that the subject matter claimed is a new and useful composition of matter not previously known or described and superior in many respects to any previously known composition, filling a long-felt want and not obvious to others in the industry.

They have apparently looked for genius or some touch of the supernatural and overlooked the tangible step of progress actually produced.

A composition of matter essentially consists of a mixture of old ingredients. If the composition is new and useful and not obvious to persons skilled in the art, it meets the statutory requirements for the grant of a patent (R. S. 4886).

It is not clear how unusual genius could be demonstrated in any composition of matter. Essentially the process of invention involved in producing a composition of matter is in mixing the right ingredients in the right proportions and discovering the new and useful properties in a resulting composition. If the producer of a new composition of matter observes new and unusual properties in the composition which have escaped the detection of the others, he has contributed to the progress of science something which had escaped the observation of others, particularly where the ingredients of the composition had been known and available to the industry for over forty-five years (R. 34). Regardless of the type of mental labor involved in producing this new composition it was new and useful and unobvious.

The tests, however, applied by the District Court and the Court of Appeals of the District of Columbia were not objective and show no analysis of the evidence submitted to the courts on the problems involved. The decisions relied upon in the opinion of the Court of Appeals of the District of Columbia apply false and arbitrary standards in judging invention.

For instance in *Potts v. Coe*, *supra*, relied upon, the court discards all normal standards of weighing invention and says:

"In determining whether an invention has been made the character of the article or process, its novelty, and its advance over the prior art are merely evidentiary. The ultimate question is *the character of the contribution made by the inventor. There is no invention without inventive genius*" (60 USPQ 228).

"In order to evaluate the contribution of the inventor the court must reconstruct the conditions under which he worked, with emphasis on the contribution of others. This method is sharply outlined in the case of *Marconi Wireless Telegraph Co. v. United States*, because a different point of view was there considered and rejected by the Supreme Court. In his dissenting opinion Mr. Justice Frankfurter argued that inventions have always been 'parts of an evolution, the culmination at a particular moment of an antecedent process'. He asserts that the majority was wrong in using 'reconstruction by hindsight' of the state of the art in such a way as to show that the final step made by Marconi was one which could have been made by an ordinary expert of high skill. He objects to the process by which 'a judge of unusual capacity for understanding scientific matters is, by a process of intricate ratiocination, able to demonstrate the inferences that Marconi drew \* \* \*. *He repudiates the flash of genius doctrine which depends entirely upon an evaluation of individual accomplishment. Nowhere is this point of view better stated. Yet the Court declined to accept it.* Both the majority opinion, declaring the patent in question invalid, and Mr. Justice

Rutledge, in a separate dissent, are concerned only with an evaluation of the individual achievement of Marconi, considered in connection with the accomplishment of others in the field" (60 USPQ 230, italics supplied).

and in the decision in the same case on the motion to vacate, the Court says:

"We will restate the principle on which our decision rests and which appellants claim was improperly injected into the case. Where a corporation, as assignee of one of its employees, seeks a patent on a discovery made in the course of its organized technical research it must assume a different burden of proof from that imposed where the discovery is the product of *independent inventive genius*. The corporation, which in substance is seeking the patent, must show that (1) *the employee is the real inventor*, and (2) the discovery is above the level of the art current in its own corporate laboratory and other corporate laboratories with which it has connections and affiliations. Such a burden is not met merely by showing that the discovery is an advance over the art shown in technical literature outside the laboratory or in previous patent application by others" (62 USPQ 332-333, italics supplied).

The report of the National Patent Planning Commission transmitted by the President to Congress on June 18, 1943 (House Document No. 239), recommends the enactment of a declaration of policy "that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished". The Court of Appeals of the District of Columbia clearly applies the subjective test, as to the inventor's mental process, rather than the objective test of what has been accomplished and whether it exceeds the skill of others in the industry.

Apparently from the prior decisions relied upon in deciding your petitioners' case, the Court of Appeals of the



District of Columbia assumed that Lind's invention was made in the course of organized research for a corporation, although there is not one word in the record which would indicate whether the inventor was working alone or as part of a research group.

It also assumed that as a worker in an organized corporate research group, Lind should be held to a higher standard of invention over prior known and published art than would an independent worker. It also assumed that the inventor's mental process by which the invention was arrived at is more important than the amount of advancement of the science which the invention contributes.

As neither of these assumptions is well founded in fact or sound in law, the petition for writ of certiorari should be granted so that this Court may state whether subjective standards or objective standards of judging invention are to be applied, and whether discrimination in the applications of such standards is to be applied as between inventors employed by corporations and individual inventors, or whether all inventors have equal standing before the courts regardless of their conditions of servitude.

As to claims 1 to 3 the District Court and the Court of Appeals of the District of Columbia have assumed unto themselves the primary Patent Office function of determining patentability contrary to the principles of administrative law previously laid down by this Court.

Respectfully submitted,

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